

REMARKS

Claims 1-47 are pending. The Office Action dated June 3, 2004, has been carefully reviewed. Reconsideration of the grounds of rejection is respectfully requested in view of the remarks herein.

Summary of the Office Action

The Examiner has rejected claims 1-47 under 35 U.S.C. 103(a) as being unpatentable over Ramaswami et al, "The May List of the 'Winners' and 'Losers' Using the Lehman Enhanced Momentum (LEM) Model for the S&P 500 and for the FTSE Europe" (the "Publication") in view of U.S. Patent No. 6,484,151 to O'Shaughnessy.

Response

It is believed that the Publication forming the basis of the Examiner's rejection is that attached hereto. The Examiner states in the Office Action that the Publication is dated May 13, 1999. However, the first page of the Publication indicates that its publication date is May 12, 2000. May 12, 2000 is, indeed, its date of publication. See Declaration of James Hosker, transmitted herewith and incorporated herein by reference. While pages 2 through 6 of the Publication indicate a date of May 12, 1999, this is a mistake. Indeed, the Publication references and reports on data collected during the year 2000, and articles published in the year 2000, thereby making a May 12, 1999 publication date an impossibility. In addition, the copyright notice on the last page of the publication indicates a 2000 publication date. (Applicants note that the Publication was inadvertently listed twice in the Information Disclosure Statement submitted in this case – once with the correct publication date of May 12, 2000 and once with the incorrect publication date of May 12, 1999.) For the foregoing reasons, the Publication is not prior art under 35 USC § 102(b).

Furthermore, the Publication is not prior art under 35 USC § 102(a). The Publication is co-authored by the two inventors of the subject matter claimed in this application (Murali Ramaswami and James Hosker), along with Alex Budny, who is not an inventor of the subject matter claimed in this application. See Declaration of Alex Budny, transmitted herewith and incorporated herein by reference. Mr. Budny has confirmed, with respect to the Publication, that he learned or received knowledge about the invention from the inventors, that he is not a co-inventor of the subject matter claimed in this application, that he merely was involved in respect of the invention to carry out assignments and work under the supervision and direction of the inventors, and that he was listed as co-author in order to receive credit for having collaborated in the research program under the inventors' direction.

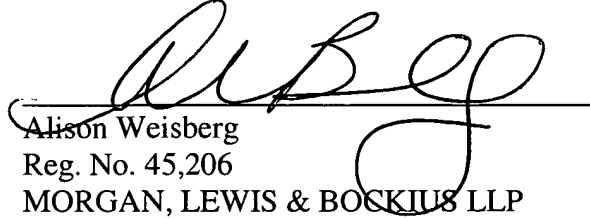
O'Shaughnessy is directed to using a computer to select corporate stocks for investment and does not disclose, teach or suggest the claimed invention.

Therefore, independent claims 1, 7, 11, 13, 19, 23, 31, 32 and 33 are allowable. The remaining claims depend variously from these independent claims. Because these claims depend from allowable base claims, such claims are similarly allowable.

In view of the foregoing amendments and remarks, it is submitted that all pending claims are in condition for allowance. A Notice of Allowance is therefore earnestly solicited.

The Commissioner is hereby authorized to charge any fees due in connection with this filing Deposit Account **50-0310**. A duplicate of this authorization is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Alison Weisberg', is written over a horizontal line.

Alison Weisberg

Reg. No. 45,206

MORGAN, LEWIS & BOCKIUS LLP

1701 Market Street

Philadelphia, PA 19103

215-963-5091

Dated: _____

Aug 4, 2004